

NIT-295

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: T. ENDO et al.
Serial No.: 09/940,982
Filed: August 29, 2001
For: TAMPER RESISTANCE DEVICE
Group: 2137
Examiner: Z. Davis

RECEIVED
CENTRAL FAX CENTER

JUL 20 2007

**REQUEST FOR RECONSIDERATION
OF DECISION ON PETITION**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 20, 2007

Sir:

The Applicants have received a Decision on Petition under 37 CFR 1.181, mailed July 10, 2007. The Applicants request reconsideration as follows.

Essentially, the Decision holds that the paper filed November 24, 2006 and entitled "Preliminary Amendment" was not, in essence, a preliminary amendment, but rather of the nature of a Supplemental Reply because a proper Request for Continued Examination (RCE) in an application finally rejected was filed with the required submission on November 8, 2006, constituting a reply to the final Office Action dated May 8, 2006, such that the subsequent paper filed on November 24, 2006 was not preliminary in nature. Therefore, according to the Decision, non-entry and consideration of the new claims contained therein was proper, as being within the discretion of the Examiner.

U.S. Application No. 09/940,982

Respectfully, although the Applicants follow the reasoning of the Decision, the Applicants nevertheless request reconsideration in light of the fact that a long period of time elapsed between the filing of the new claims on November 24, 2006 and the mailing of the subsequent Office Action on February 20, 2007, in which the Examiner indicated as reasons for not entering the new claims, not the burden of the delayed filing, but simply that they are not entered as a matter of right, and that they are not clearly limited to the responses provided for by 37 CFR 1.111(a)(2)(i) (this section sets forth those responses that are enterable as a matter of right). Thus, in essence, the reason for not entering the new claims is that they are not enterable as a matter of right.

Respectfully, the result of the Examiner's exercise of discretion is that a further cycle of action-and-response must be undertaken, with seemingly no benefit to the prosecution of the application. The additional cycle prolongs the examination of the application for no effective reason. The two sets of claims (that is, the claims examined in the February 20 Office Action and the set of claims filed November 24, 2006 that were not examined) could have been examined at the same time, and acted upon in the same Office Action mailed February 20, 2007, without undue burden to the Examiner, who had the new claims well in advance of the action. Further, an examination on both sets of claims might have resulted in progress on one set of claims versus the other, leading to an earlier allowance. Expedited prosecution of this sort is desirable for both the Office and the Applicants, and absent a better reason than "entry is not a matter of right", it does not appear that benefit is gained by the refusal to examine the second set of claims.

Accordingly, the Applicants respectfully request reconsideration of the Decision, entry of the amendments filed November 24, 2006, and appropriate action


U.S. Application No. 09/940,982

on the claims in due course. It is noted that, because the time for responding to the Office Action of February 20, 2007 is not stayed by the Petition or Decision, a Reply was filed July 20, 2007 adding the claims at issue to the present application. If this Request for Reconsideration is granted, the Applicants further request that the ensuing Office Action be made non-final to restore the aspect of the case as it would have enjoyed had the claims been entered pursuant to the paper filed November 24, 2006.

Although no fee is believed to be due for consideration of this request, any fee that is, indeed, due may be charged to Deposit Account No. 15-1417 (referencing attorney docket no. NIT-295).

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.


Daniel J. Stanger
Registration No. 32,846

DJS/sdb
(703) 684-1120